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"PATENT"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	Before the Examiner
James T. Carey, et al.)	Ellen M. McAvoy
U. S. Serial No. 10/678,547)	Confirmation Number: 2518
Filed: October 3, 2003)	Group Art Unit: 1764
LOW-VOLATILITY FUNCTIONAL)	
FLUIDS USEFUL UNDER CONDITIONS)	Family Number: P2002J111 US2
OF HIGH THERMAL STRESS AND)	
METHODS FOR THEIR PRODUCTION)	
AND USE)	

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

ARGUMENTS

Examiner and applicants agree that the prior art fails to disclose the limitation of "a ratio of measured-to-theoretical low-temperature viscosity equal to about 1.2 or less, at a temperature of about -30°C or lower, where the measured viscosity is cold-crank simulator viscosity and where theoretical viscosity is calculated at the same temperature using the Walther-MacCoul equation."

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the
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August 17, 2007
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CLAIM REJECTIONS 35 USC 103

The Examiner has rejected the claims for allegedly being obvious over four cited references. Examiner admits, "Applicant's invention differs in independent claims 1, 2, 13 and 14 by including property (c)." Examiner then argues, "Although the premium synthetic lubricants of [the references] are not characterized by such values, the examiner is of the position that the claimed functional fluids may be the same as those disclosed in [the references] since the properties of VI and pour point may be the same, and since the claimed functional fluid may be prepared by the same process."

In the previous rejection, applicant's requested that the Examiner, "state specifically where in the prior art it teaches the claimed combination of specific steps to achieve the claimed properties or remove the rejection." The Examiner did not address this request. Applicants have submitted an affidavit showing that unless the specific claimed steps are followed the claimed properties will not be achieved. The affidavit further states the prior art references are not enabling disclosure. Examiner is picking and choosing various steps in the prior art based on hindsight reasoning with the benefit of applicant's disclosure. Once again, applicant's are asking Examiner to state why she is picking each step from references listing many alternative steps and where does the prior art show that using such a combination of steps would result in the desired properties. Applicants are also requesting a statement on how the prior art enables the claimed invention including the claimed properties.

The Examiner's statement that, "Although the premium synthetic lubricants of [the references] are not characterized by such values, the examiner is of the position that the claimed functional fluids may be the same as those disclosed in [the references] since the properties of VI and pour point may be the same, and since the claimed functional fluid may be prepared by the same process" is pure speculation without any

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supportive evidence. As stated above, her statement is further refuted by the expert affidavit submitted by applicants. Applicants are officially challenging this factual assertion as not properly officially noticed or not properly based upon common knowledge.

MPEP §2144.03(c) states, "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence". Applicant's affidavit clearly states the "cited references are not an enabling disclosure" and "The prior art does not disclose the importance of hydrodewaxing with a dewaxing catalyst in combination with the other steps to produce a lubricating oil with the claimed properties." Applicants further supported this with comparative data that demonstrates unless the proper steps are followed in the specification the claimed properties would not be achieved. 37 CFR 1.104(d)(2) requires, "When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanations by the affidavits of the applicant and other persons." Accordingly, Applicants are requesting under 37 CFR 1.104(d)(2) an affidavit on how a person skilled in the art would know that following a specific combination of steps would result in a base stock with certain claimed properties that are not disclosed in the prior art without the hindsight benefit of applicant's disclosure.

In addition, the Examiner did not address several dependant claims. These claims include a functional fluid with an additive package without a viscosity index improver (claim 9). Many of the low temperature properties including viscosity index and pour point are achieved without viscosity index improvers. Examiner ignores the fact that many of the cited references are for fully formulated base stocks whereas

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applicant's claim improved properties from the base stock. In addition, applicants are using these functional fluids for circulating oils (claim 10), compressor oils (claim 11), and an internal lubricant for sintered metal materials (claim 12). The Examiner fails to show where the prior art shows these types of oils and lubricants have the claimed properties. Accordingly, Examiner should remove the rejection or at least remove the final rejection until these limitations are addressed.

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REMARKS

The claims are now patentable over the prior art. The prior art does not teach the desired claimed properties nor enable the specific combination of steps to achieve the claimed properties.

Respectfully submitted,



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☒ Pursuant to 37 CFR 1.34(a)

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